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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/814,373	03/31/2004	Andrew L. Oleson	1199 P 196	5499
26952	7590	03/11/2005	EXAMINER FERGUSON, MARISSA L	
ROGER H. STEIN 311 S. WACKER DRIVE 53RD FLOOR CHICAGO, IL 60606-6622			ART UNIT 2854	PAPER NUMBER

DATE MAILED: 03/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/814,373

Applicant(s)

OLESON, ANDREW

Examiner

Marissa L. Ferguson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 51 and 52 is/are allowed.
- 6) ☒ Claim(s) 1,2,4-6,8-15,17-19,21-30,32-34,36-50 and 53-58 is/are rejected.
- 7) ☒ Claim(s) 3,7,16,20,31 and 35 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1,2,6,12,13,25,26,29-31,34,40,41,44,45-47,50 and 53-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oleson (US Patent 5,953,987) in view of Holderegger (US 5,437,925).

Regarding claims 1,29,45,53, Oleson teaches the apparatus and method comprising a frame (11) and frame holders (23) and fastener elements for securing the frame (24) located between the frame and frame holder. However he does not explicitly disclose a pair of shims with a thickness positioned between the frame and the holder. Holderegger teaches a stencil holder with a pair of shims (19). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the invention as taught by Oleson to replace fastener thereof with a pair of shims as taught by Holderegger, since Holderegger teaches that it is advantageous to provide a snug and secure connection thereby firmly locking the frame in position.

Regarding claims 2,6,12,13,25,26,29,30,34,40,41,45,46,47 and 54-55, Oleson teaches the claimed invention with the exception of at least one or a pair of fasteners that are bolts/rivets passing through an aperture in a supporting surface of the frame holder below the frame and either into or through the shim. Holderegger teaches a pair

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of bolt rivets (17) that pass through apertures (20) and through the shims (19 and Figure 1). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the invention as taught by Oleson to replace clamp fastener thereof with a pair of bolts/rivets as taught by Holderegger, since Holderegger teaches that it is advantageous to avoid undue tension and warping when tightening a printing plate.

2. Claims 4,5,8-11,21-24,32,33 and 36-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oleson (US Patent 5,953,987) in view of Holderegger (US 5,437,925) as applied to claim 1 above, further in view of Elliott et al. (US Publication 2004/0244172).

Oleson and Holderegger both teach the invention claimed with the exception of a bolt passing through the aperture and frame holder thereby exposing a threaded bolt end fastener and wherein a nut is screwed at the bolt end. Elliott et al. teaches a shim assembly that uses a threaded bolt (26 and Page 1, Paragraph 0013) to pass through an aperture and a frame member exposing the end of the bolt (Figure 4) and connects the bolt end with a rivet nut (14). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to further modify the invention as taught by Oleson to replace a threaded bolt fastener thereof with a bolt/nut that wherein the bolt is exposed at the end as taught by Elliott et al., since Elliott et al. teaches that it is advantageous to accurately and securely fasten the body to a frame in order to prevent noise and vibration.

3. Claims 14,15,19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oleson (US Patent 5,953,987) in view of Holderegger (US 5,437,925).

Oleson and Holderegger both teach the invention claimed including a pair of shims, however they do not explicitly disclose a second pair of shims wherein the shims are fastened between the frame holder and frame. However, it has been held that mere duplication of the essential working parts of a device involve only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. It would have been obvious to add a second pair of shims since such a modification would result in a frame being properly secured to a frame holder.

4. Claims 17,18 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oleson (US Patent 5,953,987) in view of Holderegger (US 5,437,925) as applied to claims 1 and 15 above, and further in view of Elliott et al. (US Publication 2004/0244172).

Oleson, Holderegger and Elliott et al. teach the invention claimed including exposing a bolt end and a nut screwed at the end of the bolt, however they do not explicitly disclose a second pair of shims wherein the shims are fastened between the frame holder and frame. However, it has been held that mere duplication of the essential working parts of a device involve only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. It would have been obvious to add a second pair of shims since such a modification would result in a frame being properly secured to a frame holder.

5. Claims 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oleson (US Patent 5,953,987) in view of Holderegger (US 5,437,925) as applied to claim 14 above, further in view of Elliott et al. (US Publication 2004/0244172).

Oleson and Holderegger both teach the invention claimed with the exception of a bolt passing through the aperture and frame holder thereby exposing a threaded bolt end fastener and wherein a nut is screwed at the bolt end. Elliott et al. teaches a shim assembly that uses a threaded bolt (26 and Page 1, Paragraph 0013) to pass through an aperture and a frame member exposing the end of the bolt (Figure 4) and connects the bolt end with a rivet nut (14). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to further modify the invention as taught by Oleson to replace a threaded bolt fastener thereof with a bolt/nut that wherein the bolt is exposed at the end as taught by Elliott et al., since Elliott et al. teaches that it is advantageous to accurately and securely fasten the body to a frame in order to prevent noise and vibration.

6. Claims 25,26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oleson (US Patent 5,953,987) in view of Holderegger (US 5,437,925).

Oleson teaches the claimed invention with the exception of at least one or a pair of fasteners that are bolts/rivets passing through an aperture in a supporting surface of the frame holder below the frame and either into or through the shim. Holderegger teaches a pair of bolt rivets (17) that pass through apertures (20) and through the shims (19 and Figure 1). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the invention as taught by Oleson to

replace clamp fastener thereof with a pair of bolts/rivets as taught by Holderegger, since Holderegger teaches that it is advantageous to avoid undue tension and warping when tightening a printing plate.

However, Oleson and Holderegger do not explicitly disclose a second pair of shims wherein the shims are fastened between the frame holder and frame. However, it has been held that mere duplication of the essential working parts of a device involve only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. It would have been obvious to add a second pair of shims since such a modification would result in a frame being properly secured to a frame holder.

7. Claims 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Oleson (US Patent 5,953,987) in view of Holderegger (US 5,437,925) as applied to claims 1 and 14 above, further in view of Williams (US Patent 5,979,312).

Oleson and Holderegger both teach the invention claimed with the exception of the outer edges of the shims are contoured to match the supporting surface. Williams teaches a support frame with a stencil with shims (28-31) that contour with the stencil (Figure 6). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to further modify the invention as taught by Oleson to replace the shims thereof with a pair of contouring shims as taught by Williams, since Williams teaches that it is advantageous to avoid or minimize any irregularity or distortion of the stencil sheet.

8. Claims 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Oleson (US Patent 5,953,987) in view of Holderegger (US 5,437,925).

Oleson and Holderegger both teach the invention claimed, however they do not explicitly disclose color-coded shims. However, it has been held to be within the general skill of a worker in the art to select a color and/or material on the basis of suitability for the intended use. In re Lashing, 125 USPQ 416. It would have been obvious to provide color-coded shims in order for the operator to properly place the shims in the correct order.

9. Claims 42,48 and 56 rejected under 35 U.S.C. 103(a) as being unpatentable over Oleson (US Patent 5,953,987) in view of Holderegger (US 5,437,925) as applied to claims 1 and 14 above, further in view of Williams (US Patent 5,979,312).

Oleson and Holderegger both teach the invention claimed and method with the exception of the outer edges of the shims are contoured to match the supporting surface. Williams teaches a support frame with a stencil with shims (28-31) that contour with the stencil (Figure 6). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to further modify the invention as taught by Oleson to replace the shims thereof with a pair of contouring shims as taught by Williams, since Williams teaches that it is advantageous to avoid or minimize any irregularity or distortion of the stencil sheet.

10. Claims 43,49 and 57 rejected under 35 U.S.C. 103(a) as being unpatentable over Oleson (US Patent 5,953,987) in view of Holderegger (US 5,437,925).

Oleson and Holderegger both teach the invention claimed and method, however they do not explicitly disclose color-coded shims. However, it has been held to be within the general skill of a worker in the art to select a color and/or material on the

basis of suitability for the intended use. In re Leshin, 125 USPQ 416. It would have been obvious to provide color-coded shims in order for the operator to properly place the shims in the correct order.

11. Claims 44,50 and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oleson (US Patent 5,953,987) in view of Holderegger (US 5,437,925).

Oleson and Holderegger both teach the invention claimed including a shim with thickness, however they do not explicitly disclose the claimed ranges of shim thicknesses of 1/16", 1/18" and 3/16". However, it has been held that where general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233. It would have been obvious to provide the claimed thickness in order to ensure a tighter connection between the shim members.

Allowable Subject Matter

12. Claims 3,7,16,20,31 and 35 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

13. Claims 51 and 52 are allowed.

Reasons for Allowance

14. The following is a statement of reasons for the indication of allowable subject matter: regarding claims 3,7,16,20,31 and 35, the prior art does not teach a seat or a pair of seats built into the shim, wherein the pair of bolts pass through the aperture of the frame holder and screw into the pair of seats.

Regarding claims 51 and 52, the prior art does not teach a method for modifying an existing printing press to accept a pair of height-adjusting shims comprising the steps of: positioning each one of the pair of shims on each of a pair of opposed frame holders, determining at least one location for an aperture on each of the opposed same holders to facilitate fastening of the pair of shims to the pair of opposed frame holders; positioning a drill bit on each of the opposed frame holders at the determined location and drilling a hole in each of the opposed frame holders at the determined location.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marissa L. Ferguson whose telephone number is (571) 272-2163. The examiner can normally be reached on (M-T) 6:30am-4:00pm and every other (F) 7:30am-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld can be reached on (571) 272-2168. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MLF

Marissa L Ferguson
Examiner
Art Unit 2854



REN YAN
PRIMARY EXAMINER